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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cerner Corporation

Serial No. 76438049

Michael J. Gross of Shook Hardy & Bacon L.L.P. for Cerner Corporation.

Jason F. Turner, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Bucher, Drost and Cataldo, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Cerner Corporation seeks registration on the Principal Register of the mark **CLINICALLY DRIVEN RESOURCE PLANNING** for goods recited in the application, as amended, as follows:

"computer software for use in the healthcare field, namely software for managing, storing, analyzing, maintaining, processing, structuring, reviewing, building, editing, distributing, communicating, organizing, sharing, referencing, monitoring and integrating healthcare related information;

computer software for automating healthcare processes, namely, resource management".¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation under Section 2(e)(1) of the Trademark Act based upon the ground that the mark is merely descriptive when considered in relation to applicant's identified goods, i.e., that the phrase "clinically driven resource planning" immediately informs potential purchasers about a significant characteristic, purpose or function of applicant's goods.

Applicant and the Trademark Examining Attorney have each filed a brief on the issues involved in this appeal, but applicant did not request an oral hearing before the Board.

We affirm the refusal to register.

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys information of significant ingredients, qualities, characteristics, features, functions, purposes or uses of the goods or services with which it is used or is

¹ Application Serial No. 76438049 was filed on August 5, 2002 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

intended to be used. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978) [GASBADGE merely descriptive of a "gas monitoring badge"]. See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) [MONTANA SERIES and PHILADELPHIA CARD merely descriptive of "credit card services." The Court found that a "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"]. Hence, the ultimate question before us is whether the phrase **CLINICALLY DRIVEN RESOURCE PLANNING** conveys information about a significant characteristic, purpose or function of applicant's goods with the immediacy and particularity required by the Trademark Act.

A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) [APPLE PIE merely descriptive of potpourri mixture]; and In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986) [BED & BREAKFAST REGISTRY

merely descriptive of "making lodging reservations for others in private homes"].

The question of whether a particular term is merely descriptive is not decided in the abstract. That is, when we analyze the evidence of record, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods are after seeing applicant's mark alone. In re Abcor, *supra* at 218 ["Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"]. See also In re Home Builders Association of Greenville, 18 USPQ2d 1313, 1317 (TTAB 1990) [NEW HOME BUYER'S GUIDE when used in connection with "real estate advertisement services"

NewHome
BUYER'S GUIDE

immediately conveys the idea of advertising in a new home guide for buyers]; and In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985) [APRICOT is merely descriptive of dolls applicant promotes as being apricot-scented]. Rather, the proper test in determining whether a term is merely descriptive is to consider the alleged mark in relation to the goods or services for which registration is sought, the

context in which the mark is used, and the significance that the mark is likely to have on the average purchaser encountering the goods or services in the marketplace. See In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859



(Fed. Cir. 1987) [the term "**first tier**" describes a class of

banks]; In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996) [the term VISUAL DESIGNER is merely descriptive of "computer programs for controlling the acquisition of data from measurement devices"]; In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995) [SUPER BUY is laudatory for "cigars, pipe tobacco, chewing tobacco and snuff"]; In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991) [MULTI-VIS is merely descriptive of multiple viscosity motor oil]; In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986) [DESIGN GRAPHIX merely descriptive of computer graphics programs]; and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979) [COASTER-CARDS merely descriptive of coasters suitable for direct mailing].

Applicant argues that its term "Clinically Driven Resource Planning" is, at worst, merely suggestive, that the Trademark Examining Attorney has improperly dissected its

proposed mark, that the composite mark as a whole could be seen as having other meanings, and that the submitted evidence does not illustrate that the proposed mark is descriptive as applied to the identified goods. By contrast, the Trademark Examining Attorney argues that taking dictionary definitions of each of the words, the resulting composite phrase immediately describes the identified goods, namely, that it is software for healthcare resource management based on patient observation. The Trademark Examining Attorney alleges that he has considered the mark as a whole, and has demonstrated that the entire mark is descriptive of the identified goods. He argues that the LEXIS/NEXIS evidence of record, applicant's brochure and website all support this same conclusion.

We turn first to the dictionary definitions of record for each of the four words making up this composite phrase:

clinically involving or based on direct observation of the patient²

driven motivated by or having a compulsive quality or need.³

resource something that can be used for support or help and an available supply that can be drawn on when needed.⁴

² THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (Third Edition 1992).

³ *Id.*

⁴ *Id.*

planning to formulate a scheme or program for the accomplishment, enactment, or attainment of.⁵

The Trademark Examining Attorney then combines these definitions, concluding that the composite phrase would mean "managing the supporting materials or available supply for the accomplishment of goals based upon the direct observation of patients."

In conducting his initial Lexis/Nexis search, the Trademark Examining Attorney also broke the phrase up into its two primary components. As to the first two words, he found more than sixty NEXIS stories having the term "clinically driven," including the following examples:

HEADLINE: *"Hooked on Medicare: The program distorts our health care"*

... motive into play in the industry and offers another temptation for providers to alter their behavior in ways that are financially as well as **clinically driven**. It promotes rather than stymies the existing entitlement culture. ...⁶

HEADLINE: *"Health care advocates decry Medicaid cuts"*

... technology has really made drugs for the mentally ill so much better," she said. "The idea that they would become cost-driven rather than **clinically driven** is unconscionable to me. We're balancing the budget on the backs of people who cannot do anything for themselves." ...⁷

⁵ *Id.*

⁶ *The Times Union* (Albany NY), October 20, 2002.

⁷ *The Tampa Tribune*, April 25, 2001.

HEADLINE: *"Managing Doctors"*

...
"Sometimes doctors have no idea how to make the transition from **clinically driven** to market-oriented practices," Murphy said. ...⁸

HEADLINE: *"How BJC Health System Revamped its IT system after Consolidation"*

...
Project Spectrum is independent of the hospitals' payroll and accounts payable information, making it a **clinically-driven** system. ...⁹

HEADLINE: *"From upside down to back on track"*

...
When Reismann took over the business, she changed the company from a traditional supplier of specialized mattresses to a more **clinically driven** wound care management company with a focus on consulting and wound dressings. ...¹⁰

HEADLINE: *"Who picks your drugs; these days, maybe your insurer"*

... "Why should I do that for a formulary choice that economically driven, not **clinically driven**? If a medication is succeeding at keeping a woman's high blood pressure under control, why fool with it, just because she ...¹¹

HEADLINE: *"Hospital closing draws challenge; Benefits to mentally ill questioned"*

... "Planning around the needs of people with mental illness should always be **clinically driven** rather than fiscally driven. What started the closure of Worcester State Hospital was a budget cut to the Department of Mental Health ..."¹²

⁸ Chicago Tribune, March 13, 2000.

⁹ The Bond Buyer, September 14, 1999.

¹⁰ Memphis Business Journal, August 6, 1999.

¹¹ The Record (Bergen County, NJ), June 6, 1999.

¹² Telegram & Gazette (Worcester, MA), March 26, 2003.

HEADLINE: *"Sen. Wright's interest in issue questioned"*

...

We are embarking on an exciting opportunity for an improved system of care. Our new system will be more **clinically driven** for better patient care, while using the great social work apparatus that was previously in place. ...¹³

HEADLINE: *"NovaCare buys local occupational health clinics"*

... Although NovaCare offers savings from economics of scale, it provides "clinical excellence" to its patients, he said. Also, Nova Care is "a **clinically driven** company," with the physicians at the top of an inverted pyramid hierarchy and the chief executives at the bottom.

...

¹⁴

In fact, combining the dictionary definitions for these two words, one would expect "clinically driven" would mean, in context, "motivated by patient needs." Applicant seems to agree with this general connotation of this two-word term as well:

[J]udging from the evidence submitted by the Examining Attorney, the term "clinically driven" is most often used to identify a more technical motivating factor as distinguished from other motivating factors, many of which are financial incentives, variously described in the cited articles as fiscally, financially, market-oriented, economically or cost-driven.

¹³ Ventura County Star (CA), March 6, 1999.

¹⁴ Business Journal-Sacramento, July 17, 1998.

Applicant's brief, p. 6. Interestingly, this appears to be the exact meaning that applicant intends to convey with the first two words of its mark: "Applicant's software is used in the healthcare field to assist healthcare businesses in properly utilizing and coordinating their supplies and information stemming from technical or medical activities, as opposed to financial or business considerations." *Id.*

As noted earlier, the question of whether a particular term is merely descriptive is not decided in the abstract, but in light of software for dealing with healthcare related information. Accordingly, we do not take seriously applicant's suggestion that "clinically" could refer to clinics for "divorce, reading or other educational concerns, home repair, income tax preparation, or sports training camps." Applicant's appeal brief, p. 7. As was correctly noted by the Trademark Examining Attorney, the fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. See In re Polo International Inc., 51 USPQ2d 1061 (TTAB 1999) [DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition].

Combining the dictionary definitions for the final two words, one would expect the term "resource planning" would mean, in context, "a method worked out beforehand for drawing on one's assets." "Resource" may have the connotation of any materials or possession on hand,¹⁵ natural resources such as water,¹⁶ or in some contexts, will have the connotation of "human resources."¹⁷ Applicant's identification of goods explicitly refers to "resource management" and its literature refers in a similar context to "materials management." However, most of the hits for "resource planning" the Trademark Examining Attorney included with his Final Office action (where the search was framed in a way that focused on software) were references to "enterprise resource planning" or "ERP." These entries make it clear that "enterprise resource planning" is a term of art for software systems that are used for operational planning and administration and for optimizing internal business processes, and would be broad enough to include

¹⁵ HEADLINE: "UNR, State Department, Reno Companies are training Russian entrepreneurs," Reno Gazette-Journal, February 25, 2003.

¹⁶ For example, the Trademark Examining Attorney included three stories about "water resource(s) planning": Reno Gazette-Journal, February 13, 2003; The Deseret News (Salt Lake City, UT), February 11, 2003; and Albuquerque Journal, February 10, 2003.

¹⁷ In Brief: "AMS will provide its Web-based resource planning system to the Prince William County school district and to the governments of Palm Beach County, Fla., and Cobb County, Ga.," The Washington Post, February 26, 2003.

personnel and workforce issues, product planning, parts purchasing, maintaining inventories, interacting with suppliers, providing customer service, and tracking orders:

"Based in Salinas, AgSoft, www.agsofterp.com, develops enterprise **resource planning** systems for the produce industry. The AgSoft ERP business system includes modules for managing warehouse inventory, scheduling ..." ¹⁸

"Symbol, which uses SAP's R/3 enterprise **resource planning** (ERP) applications, is considering installing some of the vendor's newer products, such as its portal software. ..." ¹⁹

"NASA is using an enterprise **resource planning** system from SAP AG to build its backbone, adding business processes as modules, ..." ²⁰

"CDC, which makes enterprise **resource planning** software for the manufacturing sector, said the acquisition of Pivotal would complement its offering. ..." ²¹

"Based in Irvine, Calif., Epicor sells software for enterprise **resource planning**, known as ERP, and customer relationship management, or CRM. ..." ²²

"Rockline also purchased Logility's freight payment and load tendering technology and is installing enterprise **resource planning** software from J.D. Edwards simultaneously" ²³

¹⁸ The Californian (Salinas, CA), February 13, 2003.

¹⁹ ComputerWorld, February 10, 2003.

²⁰ ComputerWorld, February 10, 2003.

²¹ The Seattle Post-Intelligencer, November 19, 2003.

²² Investor's Business Daily, November 13, 2003.

²³ Traffic World, November 10, 2003.

Accordingly, at least within the context of large enterprises, there appears to be a type of computer software known as "resource planning" software. In fact, applicant's website explains that its involved software "modules are designed to complement [the customer's] existing enterprise resource planning (ERP) system":

"Cerner's *Clinically Driven Resource Planning* directly connects your materials management processes to your clinical processes. With this approach, the supply chain becomes a byproduct of clinical actions. Supply usage automatically drives purchasing."²⁴

...

"Cerner's *Clinically Driven Resource Planning* incorporates four ProCure® Supply Chain System modules, which can be implemented together or individually to replace or complement your existing information systems. These modules are ... designed to complement your existing enterprise resource planning (ERP) system, the ProCure Clinical Supply Chain improves patient safety by linking the use of supplies and medications to the appropriate patient."²⁵

In addition, the brochure applicant submitted for the record states the following:

²⁴ http://www.cerner.com/products/products_4a.asp?id=148
²⁵ *Id.*

Clinically Driven Resource Planning

*Integrate your Materials Management with Clinical Processes
for a More Effective Supply Chain."*

If you want to bring new efficiencies to your supply chain, take a look at Cerner's *Clinically Driven Resource Planning*[™] applications. Our innovative solutions are unrivaled in the industry. No one else can ensure the **right clinical materials** are:

- In the **right place**
- At the **right time**
- In the **right quantity**
- Of the **right quality**
- And at the **right cost**
- To achieve the **right clinical outcome**.

How do we do it? Cerner's *Clinically Driven Resource Planning* directly connects your materials management processes to your clinical processes—from scheduling to care to outcomes. With this approach, the supply chain becomes a byproduct of clinical actions. Supply usage automatically drives purchasing.

...

...

The *Clinically Driven Resource Planning* approach also incorporates patient schedules, clinical pathways, automatic charging and outcomes reporting. This comprehensive strategy allows you to:

- Anticipate need
- Align resources
- Account for care

...

It seems according to this brochure, the "resources" include labor, supplies and equipment, and the software links these resource requirements directly to the delivery of patient care. Applicant also explains that its resource planning modules should be compatible with its customers' existing enterprise resource planning systems.

Hence, when one combines "clinically driven" with "resource planning," it seems clear that the resulting phrase immediately conveys information about this computer software. That is, according to applicant's own literature (website and brochure), this particular "resource planning" software is "driven" directly by the "clinical" processes

of the health care enterprise - and not by labor intensive efforts such as manual requisitioning, educated guesses as to inventory levels of medical supplies, complex scheduling of clinicians, etc.

It is true, as applicant charges, that the Trademark Examining Attorney did not find any third-party uses of this exact four-word phrase. However, the fact that applicant intends to be, or presently is, the first and only user, among its competitors, of the term "clinically driven resources planning" in connection with computer software for use in the healthcare field, does not justify registration when, as here, such term projects a merely descriptive significance. See In re International Game Technology Inc., 1 USPQ2d 1587, 1589 (TTAB 1986) [ON-LINE, ON-DEMAND is merely descriptive of computer lottery terminals]; In re National Shooting Sports Foundation, Inc., 219 USPQ 1018, 1020 (TTAB 1983) [SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE is merely descriptive of conducting and arranging trade shows in hunting, shooting, and outdoor sports products field]; and In re Pharmaceutical Innovations, Inc., 217 USPQ 365, 367 (TTAB 1983) [ULTRA/PHONIC is merely descriptive of diagnostic ultra sound conductivity or scanning gel].

Moreover, applicant criticizes the NEXIS hits placed into the record, citing to

In re Homes & Land

Publishing Corp., 24 USPQ2d



1717 (TTAB 1992). That case is distinguishable on several bases. First, the Trademark Examining Attorney herein did say that the dozens of NEXIS excerpts provided for the record were "random," or representative hits. Even more significantly, the cited case involved a record containing only three NEXIS excerpts, one of which clearly referred to the applicant therein. Finally, the Trademark Examining Attorney in Homes & Land Publishing Corp was facing the challenging task of demonstrating genericness. Our primary reviewing Court has placed on the United States Patent and Trademark Office a heavier burden to demonstrate genericness, including additional evidence of generic uses of the term by third parties, than is the case with merely descriptive terms. See In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) [The United States Patent and Trademark Office failed to demonstrate that the phrase SOCIETY FOR REPRODUCTIVE MEDICINE is a generic term for applicant's services].

Furthermore, we find that the Trademark Examining Attorney has not improperly dissected the mark. While he has discussed separately the various components of this phrase, he is careful to base his ultimate conclusions on the commercial impression of the mark in its entirety.

Applicant is correct in noting that in some cases where the component parts of a composite mark may be determined to be descriptive (or even generic), the combination of two or more merely descriptive components are registrable if the juxtaposition of the words is determined to be inventive or if it evokes a new and unique commercial impression. However, if each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. See In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1988) [SCREENWIPE generic for wipes that clean computer and television screens]; In re Tower Tech, Inc., 64 USPQ2d 1314, 1318 (TTAB 2002) [SMARTTOWER merely descriptive of commercial and industrial cooling towers]; In re Sun Microsystems Inc., 59 USPQ2d 1084, 1087 (TTAB 2001) [AGENTBEANS merely descriptive of computer programs for use in development and deployment of application programs].

Applicant has not explained how the juxtaposition of these terms creates a unique commercial impression. Rather, we find that when "clinically driven" with its descriptive meaning, is combined with "resource planning," with its highly-descriptive, if not generic, significance in relation to the involved goods, the new phrase comprises a composite phrase that is itself merely descriptive.

Accordingly, because the phrase **CLINICALLY DRIVEN RESOURCE PLANNING** conveys forthwith a significant characteristic, purpose or function of applicant's "computer software for use in the healthcare field, namely software for managing, storing, analyzing, maintaining, processing, structuring, reviewing, building, editing, distributing, communicating, organizing, sharing, referencing, monitoring and integrating healthcare related information; computer software for automating healthcare processes, namely, resource management" namely, that applicant's *resource planning* software systems are *driven* by the healthcare institution's *clinical* processes, it is merely descriptive thereof within the meaning of the statute.

Decision: The refusal under Section 2(e)(1) of the Lanham Act is hereby affirmed.